

REMARKS

Claims 1-25 stand finally rejected in the above-captioned application. The Examiner has asserted that Final Rejection is proper, suggesting that Applicants' amendment necessitated the new grounds of rejection presented in the Office Action dated November 24, 2008. Applicants have carefully reviewed the Office Action, and the amendments made in Applicants' prior response. Applicants traverse the propriety of the Final Rejection, consider the same to be improper, and respectfully request reconsideration leading to the withdrawal of the finality of the Office Action in light of the remarks presented herein.

Applicants respectfully submit that the final rejection of claims 1-25 is premature. In rejecting those claims anew, the Examiner has completely altered the basis for rejecting the claims over the Widmer reference (EP 1136507), has developed a novel theory of rejection, and has applied five new references in rejecting claims under Section 103(a). Applicants believe that the final rejection of claims 1-25 is premature because the Examiner has introduced new grounds of rejection in the most recent Office Action that were "neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement" (*see* MPEP § 706.07(a)). Though the MPEP § 706.07 does not permit Applicants to "dall[y] in the prosecution of his or her application" or "resort[] to technical or other obvious subterfuges in order to keep the application pending before the examiner," Applicants have done nothing of the kind to warrant this Final Rejection. Rather, Applicants' amendments merely corrected informalities noted in the Examiner's Office Action and added new composition claims for the Examiner's consideration that mirror, and are coextensive in scope to, originally filed claims 1-15. Accordingly, the final rejection of claims 1-25 prematurely ends prosecution before a clear issue has developed between the Examiner and Applicant (*see*, MPEP § 706.07, "Before final rejection is in order a clear issue should be developed between the examiner and applicant.")).

The MPEP instructs that a clear issue develops only when the Examiner has thoroughly searched the invention as disclosed and claimed and fully applied the references in the first action (*Id.*). However, applying references in a novel way, or "[s]witching . . . from one set of references to another by the examiner in rejecting in successive actions claims of substantially

the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue” for a final rejection (*Id.*). In the first office action, the Examiner used the Widmer reference to reject claims 1-3 under Section 103(a). In this final Office Action, the Examiner has abandoned the original basis for rejecting claims 1-3, and instead applied the Widmer reference under Section 102(b). Applicants can only infer that the Examiner has *switched horses* in the wake of Applicants’ response because the Examiner determined that the original non-obviousness rejection was unsustainable based on Applicants’ submitted arguments. Moreover, the Examiner has applied five new references in formulating new grounds of rejection under both Sections 102(b) and 103(a). Those new grounds of rejection are significant changes from the first office action that were driven neither by Applicant’s amendments nor by any new information submitted in an IDS. In advancing new theories of rejection and switching from one set of references to another, Applicants submit that a clearly defined issue cannot have developed between the Examiner and Applicants.

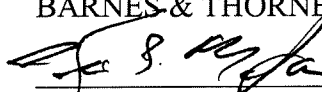
MPEP § 706.07 also instructs that “the applicant who is seeking to define her invention in claims that will give her the patent protection to which she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of her application.” Applicants’ amendment of claims 1-15 did no more than redraft the as-filed “use” claims commonly used in other countries to “method” claims; no substantive changes were made. Such amendments cannot be fairly characterized as necessitating a completely new ground of rejection based on a different point of law, or the application of new references which were already before the Examiner. Thus, Applicants suggest that the new grounds were instead necessitated by Applicants’ arguments in traverse, not by amendments that did not change the scope of the claims. Accordingly, the Examiner’s novel theories and application of new references in finally rejecting the claims has prevented a clearly defined issue from developing while at the same time precluding Applicants’ opportunity to respond. Under such circumstances, the final rejection of claims 1-25 prematurely ended prosecution. For these reasons, Applicant respectfully requests that the Examiner reconsider the rejection of claims 1-25 and withdraw the finality of this rejection.

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Application No. 10/552,244

Should the Examiner require any clarification of the foregoing remarks, Applicants invite the Examiner to contact the undersigned by electronic mail (kmclaren@btlaw.com) or by telephone (317-231-7776) to expedite the prosecution of the subject application.

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in black ink, appearing to read 'K. L. McLaren', is written over a horizontal line.

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One of the Attorneys for Applicants

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